

Appl. No. 09/944,477
Amdt. Dated October 20, 2003
Reply to Office Action of July 21, 2003

• • R E M A R K S / A R G U M E N T S • •

The Official Action of July 21, 2003 has been thoroughly studied. Accordingly, the changes presented herein for the application, considered together with the following remarks, are believed to be sufficient to place the application into condition for allowance.

By the present amendment, the limitations of dependent claim 6 have been incorporated into independent claim 1, and claim 6 has been canceled.

This change to independent claim 1 is believed to address and overcome the outstanding rejection of claims 1-6 under 35 U.S.C. §112, second paragraph for the reasons discussed below.

Entry of the changes to the claims is respectfully requested.

Claims 1-5 are pending in this application.

Claims 1-6 stand rejected under 35 U.S.C. §112, second paragraph. Under this rejection the Examiner has taken the position that the recitation of the thermoplastic fibers of the second web being "individualized" taken together with the recitation in claim 6 that the "individualized fibers are neither fused nor mechanically entangled tightly with each other" raises a question as to the meaning of "individualized."

In order to address and overcome the indefiniteness problem raised by the Examiner, the limitations of dependent claim 6 have been incorporated into independent claim 1, and claim 6 has been canceled.

Appl. No. 09/944,477
Amdt. Dated October 20, 2003
Reply to Office Action of July 21, 2003

Claim 1 presently recites that the "individual thermoplastic fibers of the second web are neither fused nor mechanically entangled tightly with each other between discrete areas where the first and second webs are joined together."

Claims 1-6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,525,407 to Ness in view of U.S. Patent No. 4,107,364 to Sisson "optionally" further taken with U.S. Patent No. 5,543,206 to Austin et al.

For the reasons set forth below it is submitted that all of the pending claims are allowable over the prior art of record and therefore, each of the outstanding rejections of the claims should properly be withdrawn.

Favorable reconsideration by the Examiner is earnestly solicited.

The Examiner has relied upon Ness as teaching that it was known at the time of applicant's invention to "form a composite elastic which included the steps of providing an elastic material and intermittently bonding the elastic to a *nonwoven fabric* on both upper and lower surfaces of the elastic material.

The Examiner has relied upon Sisson as suggesting that:

...it was known to intermittently bond a nonwoven of elastic filaments to a nonwoven of inelastic by elongatable filaments.

The Examiner takes the position that:

The reference to Sisson suggested that those skilled in the art would have bonded the nonwoven elastic web 24 with the nonelastic web 22 at cross over points 26 wherein the bonding would have been at discrete locations, see Figure 1.

Appl. No. 09/944,477
Amdt. Dated October 20, 2003
Reply to Office Action of July 21, 2003

The reference suggested that after formation one skilled in the art would have stretched the web wherein the nonelastic web would have been elongated and oriented as depicted in Figure 2. after retraction of the elastic (contraction) subsequent to elongation, the inelastic filaments 22 loop, bulk and bunch up.

The Examiner states:

...applicant is advised that one viewing Ness would have understood that the nonwoven materials of Sisson would have been useful in the operation as puckering was desired in the finished assembly.

In combining the teachings of Ness and Sisson the Examiner takes the position that:

...it would have been obvious....to employ the nonwoven web of Sisson in the process of Ness for making a textured and puckered elastic composite web.

Applicant respectfully disagrees with the Examiner's position.

Ness requires the use of at least two separate members - a non-apertures elastic member (10) and a non-gathered substrate (12). The elastic member and substrate are intermittently bonded in a regular or irregular pattern as discussed at column 3, lines 8-10 and shown in Fig. 2.

"As shown in FIG. 2, the composite may be stretched in any direction, imparting extensibility and elasticity to the composite. The elastic must have sufficient strength to pucker or gather the substrate, as shown at 16 in FIG. 3, when the tension is released." (column 3, lines 16-20).

In contrast to Ness, Sisson teaches a single layer web that includes a combination of filaments that are formed by melt spinning, mechanically thinned, combined together to form a single web, and bonded together.

Appl. No. 09/944,477
Amdt. Dated October 20, 2003
Reply to Office Action of July 21, 2003

The embodiment that includes both non-elastomeric filaments 24 and non-elastic filaments 22 (discussed at column 13, line 56 through column 14, line 46) involves "directing the textile denier filaments for looping and random or directed laydown and formation with well dispersed crossings on the forming surface..." This process forms an "unbonded web" that "may then be bonded, preferably autogenously, to produce the bonded cloth structure may then be expanded, as by stretching, to elongate both the non-elastic filaments 22 and the elastomeric filaments 24, to the configuration illustrated in FIG. 2."

Sisson teaches a single web in which the non-elastomeric filaments 24 and non-elastic filaments 22 are mixed together rather than a composite structure that comprises a first web and a second web.

Accordingly, it is submitted that one skilled in the art would not consider it obvious to modify Ness, who requires a separate elastic member and substrate, to "employ the nonwoven web of Sisson" as the Examiner suggests.

The Examiner has referred to Sisson as teaching both a "nonwoven of elastic filaments" and a "nonwoven of inelastic but elongable filaments."

It is accordingly somewhat unclear which "nonwoven" of Sisson the Examiner suggests as being obvious to employ into Ness.

Contrary to the Examiner's interpretation of Sisson, the undersigned does not believe that Sisson teaches a "nonwoven of elastic filaments" and a separate "nonwoven of inelastic but elongable filaments."

Appl. No. 09/944,477
Amdt. Dated October 20, 2003
Reply to Office Action of July 21, 2003

Rather it is believed that Sisson teaches combining thinned filaments to form a single web which is subsequently bonded.

The Examiner has stated that the "nonwoven materials of Sisson would have been useful in the operation of puckering."

However, it is noted that the "looping, bulking and bunching of the non-elastic filaments" as taught by Sisson occurs within the mixture of the non-elastomeric filaments and the non-elastic filaments as shown in the figures.

It is noted that, as shown in Fig. 9, Ness requires that only the elastic member pucker.

Accordingly, it is not clear how features of Sisson could be incorporated into Ness and function properly.

In order to properly combine the teachings of references under 35 U.S.C. §103 the Examiner has to rely upon the references as suggesting the combination. Note the federal circuit's holding in *Smithkline Diagnostics*:

The Examiner cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention; the Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 USPQ 2d 1468, 1475 (Fed. Cir. 1988)

While any rejection under 35 U.S.C. §103 that is based upon the combination of features of references involves a degree of (permissible) hindsight, there has to be some teaching in the references that suggests their combination.

Appl. No. 09/944,477
Amtd. Dated October 20, 2003
Reply to Office Action of July 21, 2003

Ness requires a non-apertured elastic member and a substrate that may comprise a plastic film, a woven, a nonwoven, a knitted or a fusible fabric. Sisson teaches a random laid bonded continuous filament cloth.

It is submitted that the teachings of these references do not provide any suggestion or motivation for their combination.

Note, applicant's independent claim requires extending the composite web and allowing the extended composite web to retract by an elastic contraction force of the first web to thereby obtain a composite sheet in which individual thermoplastic fibers of the second web are neither fused nor mechanically entangled tightly with each other between discrete areas where the first and second webs are joined.

Sisson teaches that the thinner filaments of the web are bonded (as shown) and does not teach that extending the web results in fibers that are neither fused nor mechanically entangled tightly with each other between areas where separate first and second web structures are joined together.

It follows that the combination of Ness and Sisson is improper and fails to render applicant's claimed invention obvious.

The Examiner has relied upon Austin as teaching the use of different webs on each side of an elastic.

The Examiner's further (optional) reliance upon Austin does not address or overcome the differences between Ness and Sisson discussed above.

Appl. No. 09/944,477
Amtd. Dated October 20, 2003
Reply to Office Action of July 21, 2003

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicant's claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejection of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

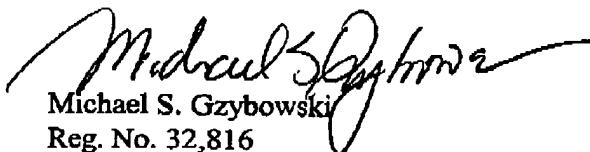
If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved, the Examiner is invited to contact applicant's patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of

Appl. No. 09/944,477
Amdt. Dated October 20, 2003
Reply to Office Action of July 21, 2003

time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



Michael S. Gzybowski
Reg. No. 32,816

BUTZEL LONG
350 South Main Street
Suite 300
Ann Arbor, Michigan 48104
(734) 995-3110

RECEIVED
CENTRAL FAX CENTER

OCT 20 2003

OFFICIAL

102392.1

-12-